

## **REMARKS**

### **INTRODUCTION**

Claims 1-38 were previously and are currently pending and under consideration.

Claims 1-38 are rejected.

Claim 7 is objected to.

Claims 1-30 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

### **CHANGES TO THE ABSTRACT**

The Abstract has been reviewed in response to this Office Action. Changes have been made to the Abstract only to place it in preferred and better U.S. form for issuance and to resolve the Examiner's objections raised in the Office Action. No new matter has been added.

### **REJECTIONS UNDER 35 USC § 101**

In the Office Action, at page 2, claims 11-13 and 22-24 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. This rejection is traversed and reconsideration is requested.

Claims 11-13 and 22-24 are amended to clarify that they are computer implemented. Therefore, they cannot "be performed by a human being with pen and paper" as suggested by the Examiner. Furthermore, According to MPEP § 2106 (IV-B-2-b-i), a "claim may still be statutory if it is limited to a practical application in the technological arts" -- a "claim is limited to a practical application [and thus patentable] when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful" (MPEP § 2106, IV-B-2-b-ii). Claims 11-13 and 22-24 produce compressed documents, which are concrete, tangible, and useful.

Withdrawal of the rejection is respectfully requested.

**REJECTIONS UNDER 35 USC §§ 102 AND 103**

In the Office Action, at pages 2-3, claims 3, 12, and 15 were rejected under 35 U.S.C. § 102 as anticipated by Fisher.

In the Office Action, at pages 3-9, claims 1, 2, 11, 14, 17, 18, 22, 23 and 25-29 were rejected under 35 U.S.C. § 103 as being unpatentable over Koontz in view of Fisher.

At page 9, claim 5 was rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Hind.

At page 10, claims 6 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Koontz in view of Fisher and further in view of Hind.

At page 10, claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Motoyama.

At page 11, claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over Koontz in view of Fisher, further in view of Motoyama, and further in view of Goodman.

At page 11, claim 9 was rejected under 35 U.S.C. § 103 as being unpatentable over Fisher in view of Motoyama, further in view of Goodman, and further in view of Hind.

At page 11, claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over Koontz, in view of Fisher, further in view of Motoyama, further in view of Goodman, and further in view of Hind.

At page 12, claim 21 was rejected under 35 U.S.C. § 103 as being unpatentable over Koontz, in view of Fisher, further in view of Arnold, and further in view of Hind.

At page 12, claims 31 and 35 were rejected under 35 U.S.C. § 103 as being unpatentable over Koontz, in view of Fisher, and further in view of Morel.

At page 13, claims 32 and 36 were rejected under 35 U.S.C. § 103 as being unpatentable over Koontz, in view of Fisher, further in view of Arnold, and further in view of Morel.

At page 13, claims 33 and 37 were rejected under 35 U.S.C. § 103 as being

unpatentable over Koontz, in view of Fisher, and further in view of Tuniman.

At page 15, claims 34 and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Koontz, in view of Fisher, further in view of Arnold, and further in view of Tuniman.

These rejections are traversed and reconsideration is requested.

#### CLAIMS 3, 12, AND 15

Amended claims 3, 12, and 15 recite markup tags. Markup tags are well known to an ordinary artisan. The tags/TAGS in Fisher are not markup tags, but rather are generic identifiers used to identify a software part independent of its actual part number, which can change.

More specifically, Fisher is for configuring newly assembled computers. In the overall configuration process, "The configuration process is driven from a description of each base model called a PRODUCT BOM" (col. 28, lines 24-26), where a "BOM" is a bill of materials. The BOM lists the software files that are copied to a computer during software pre-installation (col. 8, lines 48-51). The BOM has a TAG object which describes a software deliverable such as a system driver, an operating system, an application, etc. "Each TAG references an actual software part number. ... The TAG is used in the Product BOM instead of the actual part number to simplify maintenance operations. A TAG may be used in any number of Product BOMs, but if the software part number changes for the TAG, then only the association between the TAG and part number need change. No maintenance is required in the Product BOM" (col. 28, lines 24-42). In other words, a TAG in Fisher is simply a custom identifier that is used in lieu of a part number ("An identifier that is used instead of an actual hardware or software part number. The TAG is meant to reduce maintenance in the system when an actual part number changes.", col. 25, "TAG-NAME" entry). Also, configuration rules and other elements of Fisher's system use the TAGs to refer to the parts.

The rejection refers to column 31, lines 30-40 of Fisher as teaching identifying and processing tags. The cited portion is part of the discussion of Figure 17. Figure 17 is a process for converting hardware and software selections (descriptions) into a configuration file. The cited portion only *converts* hardware and software descriptions into tags. Again, the TAGs are

not markup tags of a structured document (e.g. XML tags, etc.).

Furthermore, it is clear that TAGs in Fisher are not markup tags, because "[t]he selected hardware TAGs and the software TAGs from the Product BOM are *combined and sorted* by the Display Order field for each TAG type", col. 28, lines 65-67). It is well known in the art that the location of a markup tags in a document is significant. Markup tags in a structured document cannot be combined and sorted (reordered).

As seen from above, the terms "tag" and "tag list" in Fisher have no relation to the structured document markup tags of the claims 3, 12, and 15. Withdrawal of the rejection of claims 3, 12, and 15 is respectfully requested.

#### CLAIMS 1, 11, 14, 17, 18, 22, 23, 25, 26, AND 29

Claim 1 recites "a structured document compressing unit for generating a plurality of compressed documents in which markup tags in individual said plural structured documents that correspond to the tag list are replaced in said plural structured documents with predetermined delimiter codes". Regarding compression, claim 1 recites that "markup tags in individual said plural structured documents that correspond to the tag list are replaced in said plural structured documents with predetermined delimiter codes". See also claims 11, 14, and 28.

Koontz discusses a method for compressing a linguistic data structure for natural language translation systems. Koontz refers to document compression but does not relate to structured documents comprising markup tags. Koontz has a different objective and basic configuration. Furthermore, Koontz's compression replaces a recurring segment with an index, which is not the same as, for example, compressing by replacing tags in the tag list of common tags (in order of appearance) with predetermined delimiters.

Withdrawal of the rejection is respectfully requested.

Claims 1, 11, 14, 17, 18, 22, 23, 25, 26, and 29 also recite markup tags, which, as discussed above, are not found or suggested in Fisher (Koontz was not cited as providing this feature).

Withdrawal of the rejection is further respectfully requested.

**CLAIMS 4, 13, 16, 19, 24, 27, AND 30**

Claim 4, for example, recites that a subdocument "is a region sandwiched between a start markup tag and an end markup tag that have a predetermined element name, from said structured document ". Arnold is cited as providing a subdocument. However, Arnold actually discloses "subordinate pieces" of information from a document. The rejection compares subordinate information to a subdocument. However, the subdocument in the relevant claims is "sandwiched between a start markup tag and an end markup tag that have a predetermined element name" in the structured document. Not only does Arnold not disclose markup-tag delimited subdocuments, but its very design obviates their necessity. Arnold is for parsing ordinary English text (natural language parsing). Column 7, lines 28-41 show the type of ordinary text parsed in Arnold – there are no *markup* tags. Arnold processes the parsed text to actually produce an XML document in which the extracted meaning (col. 5, lines 19-21) is encoded. Markup tags only appear after processing. One skilled in the art of structured documents reading the relevant claims would not confuse a sub-document defined by start and end markup tags with any arbitrary piece of "subordinate information" extracted from a document using structural models of human language and contextual information (col. 5, lines 9-12).

Withdrawal of the rejection is respectfully requested.

Claims 4, 13, 16, 19, 24, 27, and 30 also recite markup tags, which, as discussed above, are not taught or suggested by Fisher (neither Koontz nor Arnold were cited for this feature).

Withdrawal of the rejection is further respectfully requested.

**DEPENDENT CLAIMS**

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 5 recites "an attribute-bearing-tag discriminating unit for discriminating whether or not said markup tag detected by said tag detecting unit is an attribute-bearing markup tag, which has an attribute value". This feature is

not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: \_\_\_\_\_

20 Dec 2004

By: \_\_\_\_\_

  
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